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3737



Docket No. 124155-2 (14049US02)

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT APPLICATION OF:

Kienzle III

SERIAL NO.: 09/683,104

FILED: 11/19/2001

FOR: Enhanced Graphic Features for Computer
Assisted Surgery System

ART UNIT: 3737

EXAMINER: Shaw, Shawna Jeannine

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Date: July 14, 2004

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RESPONSE

TECHNOLOGY CENTER R3700

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Examiner Shaw:

This paper responds to the Office Action in the above-entitled application, mailed June 14, 2004, and allowing one month for a response. This response is timely because it is being filed within the period set for response.

ELECTION

The Examiner indicated that the Applicant is required under 35 U.S.C. 121 to elect a one of the following inventions:

- I. Claims 1-8, drawn to a computer assisted surgery system and method for insertion of guide pins into a body part including an x-ray

- imaging device and a surgical instrument, classified in class 600, subclass 427.
- II. Claims 9-16, drawn to a computer assisted surgery system and method for orienting an acetabular component during total hip replacement surgery including an imaging device and a positioning instrument, classified in class 600, subclass 424.
- III. Claim 17, drawn to a computer assisted surgery system for noninvasively determining the location of a specific point within a body including an x-ray imaging device and a probe having a real tip portion, classified in class 600, subclass 426.

The Applicant provisionally elects *with traverse* the invention of category I, namely, claims 1-8, drawn to a computer assisted surgery system and method for insertion of guide pins into a body part including an x-ray imaging device and a surgical instrument, classified in class 600, subclass 427. The Applicant requests that the Examiner reconsider this restriction requirement and withdraw it for the reasons discussed below.

TRAVERSAL

The restriction requirement is respectfully traversed because “if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.” MPEP Section 803. Thus, even if the inventions are independent or distinct, restriction is improper if the search and examination of the entire application can be made without serious burden.

One of the “two criteria for a proper requirement for restriction between patentably distinct inventions” is that “[t]here must be a *serious* burden on the examiner if restriction is not required...” *See id.* (emphasis added). While “[f]or purposes of the initial requirement a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search... [t]hat *prima facie* showing may be rebutted by appropriate showings or evidence by the applicant.” *Id.*

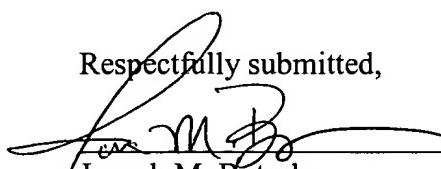
Initially, the Applicant notes that all the claims in the present application are drawn to a “computer assisted surgery system.” Moreover, each category of claims relates to orienting, locating, or inserting components within a body, in order to effectively conduct a surgical operation. Each of the three categories listed above are closely related, and in no way create a serious search and examination burden.

The Applicant respectfully submits that the search and examination of all of the pending claims can be made without serious burden to the Examiner. The listed categories are closely intertwined. That is, each is related to computer assisted surgery, and particularly to computer assisted surgery used to insert, orient, or locate components within a body. The Applicant doubts that searches for these inventions are substantially different. In fact, a search for one category will most likely be sufficient for all categories. Further, the categories are so closely related as to be in the same class of invention, namely, class 600, with closely related subclasses (i.e., subclasses 424, 426, and 427). Thus, the Applicant respectfully submits that the Examiner can search all invention categories without serious burden.

As noted above, “[f]or purposes of the initial requirement a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search.” MPEP Section 803. In this case, the Applicant respectfully submits that a *prima facie* serious burden has not been demonstrated by the Examiner. First, despite the Examiner’s assertion that the different inventions each have a “different classification,” all three categories are in the same class, namely, class 600. As such, “separate classification” has not been shown. Next, the Examiner has not demonstrated that the categories have a “separate status in the art,” nor a “different field of search.” The Examiner stated that the inventions have “acquired a separate status in the art because of their recognized divergent subject matter.” The Applicant respectfully differ. As noted above, the categories of invention are closely intertwined, and the Examiner has not offered any evidence regarding the “recognized divergent subject matter” of the inventions.

The Applicant respectfully submits that the present restriction requirement is improper because the search and examination of the claims of the application can be made without serious burden. Therefore, the Applicant respectfully requests the Examiner to withdraw the restriction requirement.

Respectfully submitted,


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